

REMARKS/ARGUMENTS

In the Office Action dated December 18, 2006, claims 1-16 were pending, with claims 1-9, and 15 allowed, and claims 10-14 and 16 rejected.

Further, Applicant appreciates the time and thoughtful analysis during an interview with the Applicant on February 20, 2007. Applicant has provided with this response a summary of the interview.

In the Office Action, claims 10-11, 13 and 16 were under 35 U.S.C. 102(b) as being anticipated by UK Patent Application No 2272604, (“Rees”). Further, claim 12 was rejected as being obvious when further considered in view of “Instant Messaging and Presence Using SIP (“Donovan”). Finally, claim 14 was rejected in light of Rees and “Official Notice.”

Discussion of Amendments to the Claims

Independent claim 10 has been amended, in part, to recite:

the receive sensitivity measuring path receiving the test signal from the terminal through an antenna.

Support for this limitation can be found, for example, in the specification at page 6, paragraph 47 and 48. Specifically, paragraph 48 of the specification states that “a first receiver 213b that receives, by coupling, signals received at the transmit and receive antenna 111.” Similarly, paragraph 49 of the specification indicates that “a second receiver 215 b that receives, by coupling, signals received at the receive antenna 121.”

Independent claim 11 has been amended, in part, to correct the grammar and to recite:

and establishes the test signal signals to be transmitted to the receive-only path.

Similarly, claim 16 has been amended to recite, in part:

transmitted by the communication system through the transmit-and-receive path ~~and a signal, which is received by the communication system through the receive-only path~~ using an antenna, and transmits the test signal to the receive-only path.

Discussion of Rejections Under 35 U.S.C. 102

In the Office Action, claim 10 was alleged to be an anticipated by Rees. Applicant has amended claim 10 to recite that the test signal is received “from the terminal through an antenna.” Because the test signal is received “through an antenna,” the antenna is a required limitation in the claim, and must be used in receiving the signal.

Rees does not disclose using the antenna to convey (e.g., with transmit or receive) a test signal. Rather, Rees discloses “a test transmitter for generating test signals; coupling means for feeding a test signal from the transmitter to each of the diversity receivers....” (Rees, page 2, lines 14-15). The selection of which diversity receiver is performed by the diagnostics system (e.g., “the diagnostics subsystem can control the feeding of the test signal to the two diversity receivers independently”; Rees, page 2, lines 26-27). The “control means for changing the signal fed to one receiver relative to the signal fed to the other receiver may comprise switch means for selectively feeding this test signal to each of the first and second receivers selectively... .” (Id., lines 32-34.)

Figure 5 of Rees is reproduced below, with the “control means” and the “switch means” identified. It is clear from Rees, that the test signal originates from the RBDS 21, through the combiner 24, to either switch 205 or 208, and then to either the diversity receiver 13 or the primary receiver 12. There is no transmitting or receiving of the test signal using the antennas. Rees directly “couples” the signal from the testing device to the receiver.

The Examiner may note that Rees does disclose the system transmitting over the RF channel at page 6, lines 2-6. However, this is explicitly defined as establishing a channel prior to performing the test. Specifically, Figure 3 is referenced, and those steps (101-103) are performed to prepare the system for the test itself, and identify a selected traffic channel for testing (step 101). The actual test occurs in step 104 of Figure 3, which corresponds to the steps in Figure 4. The text describing the test itself indicates the signals is coupled to the receiver and does not use the antennas to transmit/receive the test signal. Thus, the test signal is not transmitted over the RF channel using the antenna. Obviously, the Examiner will appreciate that testing the receiver of a system requires the terminal and the base station use a particular frequency channel, and that the use of the existing call setup procedures for allocating a channel between the test device and the base station can be used for this purpose, but once a channel is established, the testing procedures are a separate process. Rees' description of the test itself – see, e.g., page 6, line 10 -25, indicates that testing a receiver does not require involvement of the antenna, since no antenna is disclosed as being used for testing the receiver. Thus, while an antenna may be used for coordinating the frequency channel, the antenna is not used to convey the test signals.

Thus, Applicant submits that the limitation recited “the receive sensitivity measuring path receiving the test signal from the terminal through an antenna” is not disclosed by Rees, and thus without each and every element disclosed in Rees, Rees cannot anticipate the claimed invention.

Independent claim 10 as amended recites the use of the antenna and independent claim 10 is patentable over the Rees' reference. Further, because this limitation is incorporated by reference into the dependent claims 11, 12, 13 and 16, (as well as by explicit recitation in claim 16), these dependent claims are also patentable over the Rees reference.

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To anticipate the claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*Verdegall Bros. v. Union Oil Co. of California*, 814, F.2d 628, 631, 2 USPQ 1051, 1053 (Fed Cir. 1987).

Applicant submits that system of Rees represents a distinct method and system of testing from the present invention. The present invention uses “signals received at the transmit and receive antenna 111” or “signals received at the receive antenna 121” (page 6, lines 47-48 and 48-49). Rees, in contrast, does not use the antenna for conveying the test signals.

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Conclusion

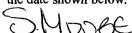
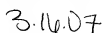
Applicant has amended the claims to better state the invention and so that the claim rejections can be withdrawn. Applicant submits that the Rees reference does not disclose the claim limitations for which it is relied upon, and thus, the combination of Rees and the other reference is still deficient to render obvious all the limitations in the dependent claims alleged to be obvious.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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<p>Customer No. 00826 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Atlanta Office (404) 881-7000 Fax Atlanta Office (404) 881-7777</p>	<p style="text-align: center;">CERTIFICATION OF ELECTRONIC FILING</p> <p>I hereby certify that this paper is being filed via the Electronic Filing System (EFS) to the United States Patent and Trademark Office on the date shown below.</p> <div style="display: flex; justify-content: space-between;"><div data-bbox="455 947 704 1006"> Shana Moore</div><div data-bbox="756 947 890 1006"> Date</div></div>
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